UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,089	11/27/2001	Richard W. Berenson	T00485.70005 INB/GSE	2527

23628	7590	02/23/2006

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EXAMINER
WILDER, PETER C

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/996,089	BERENSON ET AL.
	Examiner	**Art Unit**	
	Peter C. Wilder	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>03 February 2006</u>.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-17</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-17</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>11/27/01</u> is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to because in Figure 5 the label "Listings Cache Server" is printed over itself and Figure 6 the label Internet is double printed. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the

description: Figure 6 element 24 is not numbered in the specification and in Figure 10

element 18 is not numbered in the specification. Corrected drawing sheets in

compliance with 37 CFR 1.121(d), or amendment to the specification to add the

reference character(s) in the description in compliance with 37 CFR 1.121(b) are

required in reply to the Office action to avoid abandonment of the application. Any

amended replacement drawing sheet should include all of the figures appearing on the

immediate prior version of the sheet, even if only one figure is being amended. Each

drawing sheet submitted after the filing date of an application must be labeled in the top

margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the

drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

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1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. 101 for being nonstatutory because the

claimed invention does not read on a computer-readable medium or computer user

interface encoded with instructions. Therefore claims 9 and 10 are rejected under 35 U.S.C 101 for being nonstatutory because there is not pre or post process activity or any practical application from the processes execution.

Claim 12 is rejected to under 35 U.S.C 101 for being nonstaturtory because the claimed invention relates to a data structure. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.

Claims 13, 14, and 17 are rejected to under 35 U.S.C 101 for being nonstaturtory because the claims are directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention MPEP 2173.05(p) II

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 13, 14, and 17 are rejected because they claim an apparatus and method steps for using the apparatus. MPEP 2173.05(p) II

a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph.

Claim 15 when dependent on claim 12 recites the limitation "the program preference information." There is insufficient antecedent basis for this limitation in the claim 15 or independent claim 12.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C 112 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public
> use or on sale in this country, more than one year prior to the date of application for patent in the United
> States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by

Hendricks et al. (U.S. 5659350).

Referring to claim 1, Hendricks teaches a system (Figure 1) for helping a user

select among program options (Column 11 lines 33-36 teaches a menu that is displayed

that allows a user to select a program to watch), comprising:

a first device programmed to accept information from the user on programming

preferences (Figure 1 element 220 teaches set top terminals and Column 15 lines 28-34

teaches retrieving viewer data from the set top terminals);

a database which accepts and stores programming preference information from

the collecting client (Column 15 lines 34-38 teaches a Operations Center element 202 in

Figure 1 that receives the data and keeps a record of the data so a database has to

exist to keep the records);

a server which combines information from the database with listings information

and formats that information for presentation to the user (Column 16 lines 10-14

teaches creating menus for different headends which is then distributed to set top

terminals and Column 7 lines 41-43 teaches the operation center having at least one

computer/server); and

a second device which accepts the formatted listings information from the server

and presents it to the user (Figure 1 teaches element 220 set top terminals).

Referring to claim 2, corresponding to claim 1, Hendricks teaches the system of

where there are at least two first devices (Column 15 lines 32-34 teaches receiving data

from set top terminals).

Referring to claim 3, corresponding to claim 1, Hendricks teaches the system

where the first device is the same as the second device (Column 13 lines 47-51 teaches

keeping track of the demographics and programs viewed and Column 16 lines 10-12

teaches menus created from the viewer data is sent to specific headends which are

located in demographic areas, so the same set top terminal can transmit preference

information and receive the menu information)

Referring to claim 4, corresponding to claim 1, Hendricks teaches the system

where the presenting client does not run on the same device as the server (Figure 1

element 220 teaches the presenting client and Figure 1 element 202 teaches the server

location).

Referring to claim 5, corresponding to claim 1, Hendricks teaches the system

where the clients communicate with the server over a wide area network (Figure 3

teaches the element 220 the set top terminal communicating with the server element

202 through element 216 which is a wide area network, Column 9 lines 10-17 teaches

the cable headend as a network controller to the set top terminals so the set top

terminals are connected over a wide are network).

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 7-9 and 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated

by Alexander et al. (U.S. 6177931 B1).

Referring to claim 7, Alexander teaches a method of presenting program listings

information in a two dimensional grid (Figure 3), the method comprising the steps of:

creating a two dimensional grid where one axis (vertical axis, Figure 3) represents the

time slots in which programs are available and a second axis (Horizontal Axis in Figure

3) represents a suggested preference order of the programs in each time slot (

Column 30 lines 53-58 teaches displaying channel slots (horizontal axis) in a

descending order of importance with the favorite channel at the top of the grid); and

displaying the grid to a user (Column 2 lines 28-29).

Referring to claim 8, Alexander teaches a computer user interface for presenting

programming listings (Column 5 lines 20-53 teaches a device that displays an EPG

which contains a processor to process information, which has to have code to operate,

and memory in the device so the device is considered a computer) information

comprising:

instructions for creating a two dimensional grid where one axis (Vertical axis in

Figure 3) represents the time slots in which programs are available and a second axis

(Horizontal axis) represents a suggested preference order of the programs in each time

slot (Figure 3 represents programs and Column 30 lines 53-58 teaches displaying

channel slots (horizontal axis) in a descending order of importance with the favorite

channel at the top of the grid); and

instructions for displaying the grid to a user (Column 2 lines 28-29).

Referring to claim 9, corresponding to claim 8, Alexander teaches the computer

user interface of wherein the suggested preference order is determined, at least in part,

based on personal preference information (Column 30 lines 59-67 and Column 31 lines

1-8 teach arranging the EPG according to a viewers preference).

Referring to claim 11, Alexander teaches a displayed time-by-suggested

preference program grid (Figure 3 teaches time in the vertical axis and programs in the

horizontal axis, and Column 30 lines 53-58 teaches displaying channel slots (horizontal

axis) in a descending order of importance with the favorite channel at the top of the

grid).

Referring to claim 12, Alexander teaches a data structure (Figure 3) programmed

to represent a time-by-suggested preference program grid (Figure 3 teaches time in the

vertical axis and programs in the horizontal axis, and Column 30 lines 53-58 teaches

displaying channel slots (horizontal axis) in a descending order of importance with the

favorite channel at the top of the grid, Column 5 lines 20-45 teaches the device that

contains the EPG has a processor which has to contain a program to operate).

Referring to claim 13, Alexander teaches a device (Column 5 lines 20-53) for

displaying a program grid to a user (Column 3 lines 1-3 teach element 10 in Figure 1 a

television screen), the device programmed to:

receive program preference information (Column 8 lines 18-35);

and display a grid of programs with time as a first axis and suggested preference

as a second axis (Figure 3 teaches time in the vertical axis and programs in the

horizontal axis, and Column 30 lines 53-58 teaches displaying channel slots (horizontal

axis) in a descending order of importance with the favorite channel at the top of the grid,

Column 5 lines 20-45 teaches the device that contains the EPG has a processor which

has to contain a program to operate).

Referring to claim 14, corresponding to claim 12, Alexander teaches the device

further programmed to:

receive information on available programs (Column 8 lines 18-35); and

generate the display of the grid from the program preference information and the

information on available programs (Column 3 lines 1-7 teaches generating the EPG

display in Figure 1, and Column 30 lines 47-51 teaches customizing the display to a

users profile).

Referring to claim 15, corresponding to claim 12, Alexander teaches the device

wherein the program preference information is received from a user (Column 29 lines

12-30 teaches capturing information from the viewer).

Referring to claim 16, corresponding to claim 12, Alexander teaches the device

of wherein the program preference information is received from a server (Column 29

lines 12-30 teaches the information can come from a computer/server in the headend).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks

et al (U.S. 5659350) in view of Schein et al. (U.S. 6002394).

Referring to claim 6, corresponding to claim 1, Hendricks teaches the system

where the formatted listings information is presented in a preference menu (Column 16

lines 2-8 teaches adjusting the location of a program in a menu according to

preferences by people watching the movies in terms of how many times the movie has

been watched), but fails to teach presenting the information in the form of a grid.

Schein teaches presenting the information in the form of a grid (Figure 16A

teaches a grid).

At the time the invention was made it would have been obvious for one skilled in

the art to modify the arranging of programs in a menu function/device of Hendricks with

the grid function/device of Schein for the purpose of allowing the user to move forward

and backward in time along one channel and horizontally to move from channel to

channel (Column 22 lines 33-40, Schein).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Alexander et al (U.S. 6177931 B1) in view of Cragun et al. (U.S. 5973683).

Referring to claim 10, Alexander teaches all the limitations in claim 8, but fails to

teach the computer user interface further comprising instructions to select a program

and have all conflicting program options eliminated from the grid

Cragun teaches the computer user interface further comprising instructions to

select a program and have all conflicting program options eliminated from the grid

(Column 10 lines 36-53 teaches an adult is able to select programs for viewing and then

the guide only showing the program guide programs that they are allowed to view thus

all other conflicting programs are removed).

At the time the invention was made it would have been obvious for one skilled in

the art to modify the arranging of programs in a grid function/device of Alexander with

the program being blocking out in a program guide function/device of Cragun for the

purpose of preventing minors from viewing objectionable content (Column 10 lines 53-

56, Cragun).

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Hendricks et al. (U.S. 5659350) in view of Alexander et al (U.S. 6177931 B1).

Referring to claim 17, Hendricks teaches a server for generating program

preference information (Column 15 lines 28-55 teaches generating program preference

information on a server), the server programmed to:

send and receive program preference information (Column 15 lines 32-33

teaches receiving and Column 8 lines 15-18 teaches sending the available programs in

the form of control information signal);

send and receive information on available programs (Column 7 lines 14-16

teaches receiving and Column 8 lines 15-18 teaches sending the available programs);

but fails to teach to generate and send data sufficient to create a grid of

programs with time as a first axis and suggested preference as a second axis.

Alexander teaches to generate and send data sufficient to create a grid of

programs with time as a first axis and suggested preference as a second axis (Figure 3

teaches time in the vertical axis and programs in the horizontal axis, and Column 30

lines 53-58 teaches displaying channel slots (horizontal axis) in a descending order of

importance with the favorite channel at the top of the grid, Column 5 lines 20-45 teaches

the device that contains the EPG has a processor which has to contain a program to

operate).

At the time the invention was made it would have been obvious for one skilled in

the art to modify the program and preference information retrieval and sending

function/device of Hendricks with the program guide based on suggested preference as

an axis of function/device of Alexander for the purpose of improved product information

access by the viewer (Column 2 line 15, Alexander)

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Peter C. Wilder whose telephone number is 571-272-

2826. The examiner can normally be reached on 8 AM - 4PM Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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